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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,067	01/14/2004	Jonathan J. Hull	015358-004031US	5097

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TOWNSEND AND TOWNSEND AND CREW, LLP  
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EXAMINER
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NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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01/26/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/758,067	<b>Applicant(s)</b> HULL ET AL.	
	<b>Examiner</b> Madeleine AV Nguyen	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/17/08</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 17, 2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 20-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman et al (US Publication No. 2007/026980).

Concerning claims 20 and 25, Freeman discloses an email server for performing automatic capture archiving of electronic documents in a network environment , at least one client computer in the network environment being coupled over a network to at least one document management workstation having at least one storage disposed to receive electronic copies of documents transferred over the network, the at least one document management

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workstation being in communication with at least one of a copy (40), print (80) and facsimile (50) operation, the email server being operatively disposed to receive a copy of every email document transferred over the network from the at least one client computer, each email document being transferred over the network in response to a single user input command (50, Fig.1); cause electronic image data to be generated for each received copy of an email document, the electronic image data being generated in a format acceptable for storage in the at least one database for the at least one document management workstation, and cause the generated electronic image data to be stored in the at least one storage to perform capture archiving of the email document; wherein the at least one storage further comprises image data from capture archiving of electronic document images from the at least one of a copy, print and facsimile operation; wherein the aforementioned steps are carried out transparent to the user and without further input from the user notwithstanding the single user input command, wherein the aforementioned steps are carried out at substantially a time that the email document is transferred over the network (Fig.1; Abstract; paragraphs 0012-0016, 0018-0019, 0032-0033, 00360037, 0039-0040, 0046, 0051-0052, 0063, 0075-0076, 0085-0086, 0101-0105). The email server further forward each copy to a document management device to generate electronic image data for each copy of an email document, the electronic image data being generated in a format acceptable for storage (paragraphs 0016, 0018, 0033, 0051-0052, 0080, 0085).

Freeman does not directly teach a database to store electronic copies of document transferred over the network. However, Freeman teaches "Every document created and every document send to a person or entity is stored in a main stream." It would have been obvious to one skilled in the art at the time the invention was made to consider the main stream taught in

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Freeman equivalent to a database claimed since both of them stored electronic copies of documents transferred over the network which results in the same result.

Freeman does not specifically teach the automatic, unconscious archiving the images of the email documents transmitted over the network. However, it is noted that the images of the email document transmitted over the network are in the form of the electronic images like the electronic documents (paragraph 0013), electronic versions (paragraph 0080), electronic checks, deposits, securities transactions, reports (paragraph 0089) are all stored in the main stream so that data is widely and automatically accessible anywhere and compatibility access platforms (paragraph 0018). Freeman teaches, “the location and nature of file storage is transparent to the user, archiving is automatic while the documents can include text, pictures, animations, software programs or any other type of data (Abstract). In addition, “Users create documents by means of the new and clone operations. New creates a new, empty document and adds the document to the main stream. Clone duplicates an existing document and adds the duplicate to the main stream... Documents can also be created indirectly through the transfer operation. The transfer operation copies a document from one stream to another stream.” (paragraph 0036) and “The server is the workhorse of this embodiment handling one or more streams by storing all main stream and sub-stream documents.” (paragraph 0046) and “all mail messages, both incoming and outgoing, are intermixed with other documents in the stream...” (paragraph 0085). It would have been obvious of one skilled in the art at the time the invention was made to consider the storing or archiving of the images of the email documents (copies, duplicated or cloning of the email documents) is automatic or unconscious archiving since Freeman teaches that the storing

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of the electronic documents in the main stream (and not sub-streams) is automatic and transparent to the user (paragraph 0012).

Concerning claim 21, the last least one of the copy, print and facsimile operation comprises at least one of a copier operation, printer operation, and facsimile machine operation that archived image data for at least one of the copier operation, printer operation and facsimile operation (40, 50, 80, Fig.1).

Claim 22 and 29 are method claim of apparatus claims 20 and 25. Claims 22 and 29 are rejected for the same rationales set forth for claims 20 and 25.

Concerning claim 23-24, 26-28 and 30-32, Freeman et al further teaches the method of claims 22 and 29, wherein causing the collected image data of every email to be stored comprises storing at least one of an origin address and destination address for an email (paragraphs 0096-0098), (claim 23); causing the collected image data of every email to be stored comprises storing at least one of a date of transmission and time of transmission for an email (Figs.4-5; Abstract; paragraphs 0001, 0033, 0034, 0036, 0058, 0072, 0086), (claim 24); the destination comprises a destination client system (paragraphs 0019, 0032, 0046-0047), (claims 26, 30); the email document comprises an email document that was at least one of received and sent (paragraphs 0037, 0038, 0051, 0085-0086, 0105), (claims 27 and 31); the at least one database is configured to store image data that was archived from at least a copier operation, a printer operation and a facsimile machine operation (paragraphs 0051, 0052, 0062-0065, 0075-0076, 0085-0086), (claims 28, 32).

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Oberhaus et al (US Patent No. 6,983,308) discloses a mail synchronization of remote and local mail systems with an electronic mail-boxes used to store electronic mail over a network wherein the synchronization of two different electronic mailboxes can be performed automatically in a two-way manner without user interaction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Madeleine AV Nguyen/

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Primary Examiner, Art Unit 2625

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January 26, 2009